

DACA
[Signature]

PATENT

SN-US025009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Shuichi HIRAYAMA

Serial No.: 10/076,956

Filed: February 19, 2002

For: BOOT LINER

ATTN: GROUP DIRECTOR

Patent Art Unit: 3728

Examiner: Anthony D. Stashick

THE ASSISTANT COMMISSIONER FOR PATENTS

Sir:

Transmitted herewith is a Petition in the above-identified application:

[X] Enclosed is a check in the amount of \$130.00 to cover the Petition fee.

[X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-1836. A duplicate copy of this sheet is attached.

[X] Any additional excess claim fees under 37 C.F.R. 1.16.

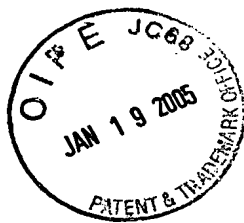
[X] Any additional patent application processing fees under 37 C.F.R. 1.17.

Dated: January 19, 2005

David J. McCrosky
David J. McCrosky
Reg. No. 56,232

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202) 293-0444

SN-US025009



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
Shuichi HIRAYAMA	:	ATTN: GROUP DIRECTOR
Serial No.: 10/076,956	:	Patent Art Unit: 3728
Filed: February 19, 2002	:	Examiner: Anthony D. Stashick
For: BOOT LINER	:	

**PETITION UNDER 37 C.F.R. §1.181 FOR RELIEF
FROM A CLAIM BEING REJECTED FOR THE FIRST TIME
IN A SECOND ADVISORY ACTION AFTER A FINAL OFFICE ACTION**

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

In response to the January 10, 2005 Advisory Action (Exhibit A), Applicant hereby petitions for relief from the first rejection of claim 28 and submits a petition fee of \$130.00 to cover this petition.

No extension fee is believed to be due for the proper submission of the petition. However, the Commissioner is authorized to charge any fees necessary associated with an extension of time to Deposit Account No. 50-1836.

Specifically, Applicant hereby petitions for relief from claim 28 being rejected for the first time in the second Advisory Action after a Final Office Action, which failed to specifically set forth any grounds of rejection for claim 28. More specifically, Applicant hereby petitions for the following:

1. A new Office Action restarting the period for reply to provide Applicant with the opportunity to fully reply to the rejection of claim 28 as a matter of right.
2. Entry of the After Final Amendment that was *submitted before all claims were finally rejected* in order to fully respond to the Final Office Action not *completely* treating claim 28.

A. SUMMARY

Applicant has not received a full and fair opportunity to respond to the grounds of rejection of claim 28 that was presented for the first time in the second Advisory Action. The Examiner has indicated that the Applicant should have known that claim 28 was rejected and the grounds of the rejection. It is *inappropriate* to expect an Applicant to *guess* what grounds of rejection, if any, should be applied against claim 28 when the Office Action is silent with respect to claim 28. In responding to the Office Action Applicant *guessed* that claim 28 might be allowable, since its scope was different from and narrower than the other independent claims. Accordingly, in response to the Office Action, Applicant *cancelled* independent claim 1 and rewrote claim 28 as an independent claim.

Now in a second Advisory Action, the Examiner wants to set forth in the record specific grounds of rejection for claim 28, because Applicant should have allegedly known which one of the rejections applies to claim 28. However, it is well settled in U.S. patent law that every claim stands on its own. Thus, Applicant should not be required to guess which grounds of rejection applies to a claim. Rather, the Examiner should be required to specifically recite the grounds of rejection. The Examiner should *not* be permitted to add many months later a grounds of rejection in a second Advisory Action.

The Examiner has refused entry of the After Final Amendment, citing further search and consideration was necessary, because the dependency of the claims were changed from claim 1, which was being cancelled, to claim 13, which was being made into an independent claim. In other words, even though all claims were previously considered, these new combinations of claims present new issues of patentability. This same logic applies to the patentability of claim 28, i.e., what grounds of rejection applies, if any. It was inappropriate to require Applicant to guess that the rejection of claim 8, which has a different and narrower scope than claim 28, should automatically apply to claim 28, merely because there are some common limitations. For a rejection to be complete, the grounds of rejection must be specifically specified in the Office Action.

Thus, Applicant believes a new Office Action should be issued restarting the period for reply to provide Applicant with the opportunity to fully reply to the rejection of claim 28 as a matter of right. Also the After Final Amendment should be entered since it was *submitted before all claims were finally rejected* and in order to fully respond to the Final Office Action not *completely* treating claim 28.

B. BACKGROUND

1. The above-identified application was filed with the U.S. Patent and Trademark Office on February 19, 2002.

2. A first Office Action on the merits was mailed by the U.S. Patent and Trademark Office on December 3, 2003.

3. An Interview was conducted on April 22, 2004 and an Interview Summary was mailed by the U.S. Patent and Trademark Office on May 4, 2004.

4. On April 29, 2004, an Amendment canceling claims 2-5 and 14, and adding new claims 26-28 was filed with the U.S. Patent and Trademark Office together with a two-month extension of time.

5. A Final Office Action (Exhibit D) was mailed by the U.S. Patent and Trademark Office on September 24, 2004 in response to the April 29, 2004 Amendment. This Final Office Action rejected claims 1, 6-13 and 15-27. The Final Office Action *did not set forth a specific grounds of rejection for claim 28*. The cover sheet of the Final Office Action listed claim 28 as rejected, but the body of the Final Office Action did not **completely** treat claim 28. In fact, the body of the Office Action was silent as to the grounds of rejection for claim 28.

6. On December 14, 2004, Applicants filed an After Final Amendment (Exhibit C) with Remarks. A request for the clarification of the status of claim 28 was made in the Remarks under the heading *Clarification of the Status of Claim 28*.

7. An Advisory Office Action (Exhibit B) was mailed from the U.S. Patent and Trademark Office on December 30, 2004 refusing entry of Applicant's December 14, 2004 Amendment and *still not addressing the grounds of rejection for claim 28*.

8. On January 3, 2005 and January 4, 2005, Applicant's Representative conducted a telephonic interview with the Examiner to verbally request the clarification of the status of claim 28. The Examiner indicated that it was apparent from the Final Office Action where claim 28 should have been rejected. Moreover, the Examiner refused to issue a new Office Action and refused to enter the December 14, 2004 Amendment.

9. A second Advisory Action and an Interview Summary (Exhibit A) were mailed by the U.S. Patent and Trademark Office on January 10, 2005. The second Advisory Action stated how the Final Office Action should have been interpreted. More specifically,

the second Advisory Action points out which of the rejections applies to claim 28. Thus, giving Applicant notice for the first time as to how claim 28 should have been rejected.

C. TIMELINESS OF THE PETITION FOR RELIEF

This Petition for Relief is made after the January 10, 2005 Advisory Action, in which claim 28 was *completely* and *properly rejected for the first time* without resetting the statutory time period for response. Therefore, this Petition for Relief is timely as required by 37 CFR 1.181(f) since it is filed within two months of the mailing date of the January 10, 2005 Advisory Action from which relief is requested.

D. INAPPROPRIATE TO STATE THE GROUNDS OF REJECTION OF CLAIM 28 FOR THE FIRST TIME IN AN ADVISORY ACTION WITHOUT RESTARTING THE TIME PERIOD TO RESPOND

Applicant respectfully requests relief from the first rejection of claim 28 in a second Advisory Action after a Final Office Action. Both the Final Office Action and the first Advisory Action were silent on the grounds of rejection of claim 28. Not until the second Advisory Action was Applicant properly notified as to the grounds of rejection of claim 28. Because a new time period upon the first rejection of claim 28 was not given, Applicant has not been given a full opportunity to respond to the grounds of rejection for claim 28. Therefore, if the U.S. Patent and Trademark Office intends to maintain the rejection of claim 28, Applicant requests that a new Office Action be issued with a new statutory time period for reply.

Specifically, the Examiner's rejection must be complete with respect to the patentability of the invention as claimed. See 37 CFR 1.104(a) *Examiner's action* states:

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. *The examination shall be complete with respect* both to compliance of the application or patent under reexamination with the applicable statutes and rules and *to the patentability of the invention as claimed* as well as with respect to matters of form, unless otherwise indicated. (Emphasis Added)

The Final Office Action was not complete in that it did not specifically and completely address the patentability of the invention of claim 28.

The Examiner must specify each rejected claim. See 37CFR 1.104(c) *Rejection of claims* states:

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly practicable. The pertinence of each reference, if not apparent, must be clearly explained and *each rejected claim specified*. (Emphasis Added)

The Examiner did not specifically state the pertinence of each reference to claim 28. Moreover, the Examiner did not specifically indicate claim 28 as rejected over any reference.

In the second Advisory Action, the Examiner has indicated that the limitations of claim 28 are addressed word for word on page 3, paragraph 3 of the Final Office Action. The Examiner has focused on the fact that the limitation for the upper portion of the boot liner are the same in independent claim 8 and dependent claim 28 but has ignored the fact that (a) claim 28 depends on claim 1 and (b) claim 28 has a different scope than claim 8.

Claim 8 states:

8. A boot liner comprising:
a sole portion; and
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section,
said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad,
said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer. (Emphasis Added)

Claim 28, incorporating the limitations of claim 1, states:

28. A boot liner comprising:
a sole portion; and
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section, said first and second banana-shaped pads being constructed of a different material than said thermoformable layer, each of said first and second banana-shaped pads being thicker than said thermoformable layer of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,
said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer, and
said upper portion includes a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad.
(Emphasis Added)

As can be seen above, claims 8 and 28 differ in scope. The fact that the two claims have the same limitation regarding the upper portion does not make it apparent that claim 28 was meant to be rejected in the same manner as claim 8, i.e., the rejection at page 3, paragraph 3 of the Final Office Action.

Indeed, since claim 8 is addressed in the Final Office Action and claim 28 is narrower but not addressed, it was not fully apparent to Applicant how (if at all) claim 28 was being rejected. Applicant thought claim 28 might be allowable because it was narrower than claim 8. Thus, the cover sheet might be a typographical error. It is not unreasonable to believe claim 28 was allowable because of its narrower scope when compared to claim 8.

The Examiner further states in the January 10, 2005 Interview Summary that Applicant has noted that the limitations of claim 28 are similar to those of claim 8. This statement is not an accurate characterization of Applicant's statement. The Examiner's statement implies that all limitations of claim 28 are similar to claim 8. This implication is not accurate. Applicant stated in the Remarks submitted with the After Final Amendment that claim 28 includes limitations similar to claim 8. As demonstrated above by the italicized portions, claim 28 includes limitations similar to claim 8. However, also as demonstrated

above, all of the limitations of claim 28 are not similar to claim 8. Claim 28 has different limitations as well. As demonstrated above, the scope of claims 8 and 28 are clearly different. Accordingly, the grounds of rejection of claim 28 is not present and certainly not apparent in the Final Office Action.

In addition, the Examiner has issued contradictory opinion on the standard of patentability of claims. In the After Final Amendment, some of the dependent claims were amended to avoid dependency on a cancelled independent claim. The Examiner found that different combination of limitations (i.e., dependent claims) raises new issues even though all of these limitations (i.e., dependent claims) were previously present. The Examiner refused to enter the After Final Amendment because changing the dependency of the dependent claims required further search and consideration. Yet, in the Final Office Action, the Examiner did not give dependent claim 28 the same attention that the amended dependent claims now require after final.

Applicant respectfully requests relief from the first rejection of claim 28 in the second Advisory Action after the Final Office Action.

***E. THE DECEMBER 14, 2004 AMENDMENT SHOULD BE
ENTERED SINCE IT WAS SUBMITTED BEFORE A
COMPLETE REJECTION OF CLAIM 28 WAS MADE***


Applicant respectfully requests relief from the Examiner's refusal to enter the December 14, 2004 Amendment. In order to fully respond to the Final Office Action not ***completely*** treating claim 28, an Amendment was filed on December 14, 2004. Claim 28 was then essentially finally rejected in a second Advisory Action mailed on January 10, 2005. Therefore, Applicant requests that the December 14, 2004 After Final Amendment be entered as a matter of right since it was submitted before all claims were finally rejected.

F. CONCLUSION

Applicant respectfully requests relief from the Examiner's action. If the Examiner wishes to maintain the rejection of claim 28, a new final office action restarting the statutory time period should be issued to provide Applicant with a full and fair opportunity to respond. Moreover, the December 14, 2004 Amendment should be entered as a matter of right since it

was submitted before all of the claims were finally rejected in order to fully respond to the Final Office Action that failed to provide the grounds of rejection for claim 28.

Respectfully submitted,


David J. McCrosky
Reg. No. 56,232

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444

Dated: January 19, 2005

EXHIBIT A



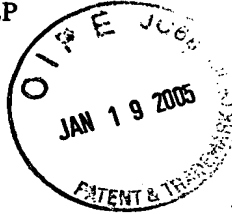
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435

22919 7590 01/10/2005

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 20TH STREET, NW, SUITE 700
WASHINGTON, DC 20036-2680



EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 01/10/2005

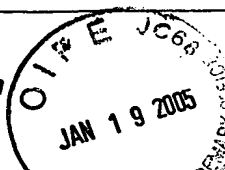
Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JAN 11 2005

Global IP Counselors, LLP



Advisory Action

Application No.

10/076,956

Examiner

Anthony Stashick

Applicant(s)

HIRAYAMA, SHUICHI

Art Unit

3728

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

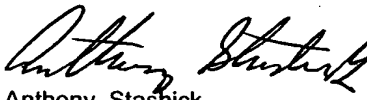
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

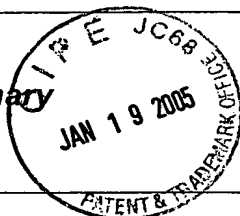
Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Anthony Stashick
Primary Examiner
Art Unit: 3728

Continuation of 10. Other: Applicant's request for clarification of claim 28 has been considered and addressed in the interview summary attached. It is noted that the limitations of claim 28 are addressed in the rejection in paragraph 3 on page 3 of the Office Action mailed 09/24/2004 and that a typographical error occurred omitting claim 28 in the preamble. Claim 28 is clearly stated as being rejected on the Office Action Summary page of the same Office Action .

Interview Summary



Application No.

10/076,956

Applicant(s)

HIRAYAMA, SHUICHI

Examiner

Anthony Stashick

Art Unit

3728

All participants (applicant, applicant's representative, PTO personnel):

(1) Anthony Stashick.

(3) _____.

(2) David McCrosky.

(4) _____.

Date of Interview: 04 January 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____.

Claim(s) discussed: 28.

Identification of prior art discussed: _____.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

ANTHONY D. STASHICK
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. McCrosky inquired about claim 28 and whether it was allowable or not. the examiner responded by saying that claim 28 was noted as being rejected on the Office Action Summary sheet of the Office Action dated 09/24/2004. The examiner further stated that on page 3, paragraph 3 of the same action, the limitaitons of claim 28 were addressed, albeit word-for-word, in the rejection and that it was a typographical error that claim 28 was not listed in the preamble of the rejection. Note: Applicant also has noted that the limitations of claim 28 are similar to those of claim 8 which is addressed in the same rejection. .

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435

22919 7590 12/30/2004

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 20TH STREET, NW, SUITE 700
WASHINGTON, DC 20036-2680

EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JAN 03 2005



Global IP Counselors, LLP

Advisory Action**Application No.**

10/076,956

Applicant(s)

HIRAYAMA, SHUICHI

Examiner

Anthony Stashick

Art Unit

3728

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: See Final Office Action.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


Anthony Stashick
Primary Examiner
Art Unit: 3728

Continuation of 2. NOTE: at least the changing of the dependency of the claims to claim 13 and the making of claim 13 an independent claim raises new issues as the limitations in claim 13 as originally filed were not necessary for the claims which now depend from claim 13.

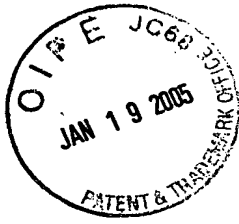
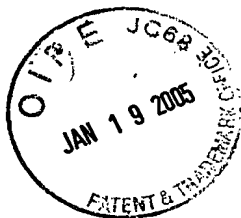


EXHIBIT C



SN-US025009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Shuichi HIRAYAMA

Serial No. 10/076,956

Filed: February 19, 2002

For: BOOT LINER

:
:
:
:
:
:
:
:
:

Patent Art Unit: 3728

Examiner: Anthony D. Stashick

***AMENDMENT AFTER
FINAL REJECTION***

AMENDMENT UNDER 37 CFR §1.116

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

In response to the September 24, 2004 Office Action, please amend the above-identified patent application as follows:

Amendments to the Claims are reflected in the *Listing of Claims*, which begins on page 2 of this paper. Claims 6-13 and 15-28 are pending, with claims 8, 13 and 28 being the only independent claims.

Remarks/Arguments begin on page 7 of this paper.

The following Listing of Claims will replace all prior versions, and listings, of claims in the application.

LISTING OF CLAIMS:

Claims 1 - 5 (Cancelled)

6. (Currently Amended) The boot liner according to claim 13, wherein said first and second banana-shaped pads are formed of a polyurethane material.

7. (Previously Presented) The boot liner according to claim 26, wherein each of said first and second banana-shaped pads has a height of approximately 70 millimeters and a length of approximately 70 millimeters.

8. (Previously Presented) A boot liner comprising:
a sole portion; and
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section,

said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad,

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer.

9. (Currently Amended) The boot liner according to claim 13, wherein said thermoformable layer further extends along said foot section.

10. (Previously Presented) The boot liner according to claim 9, wherein said thermoformable layer further extends along said leg section
11. (Previously Presented) The boot liner according to claim 10, wherein said upper portion includes a foam layer disposed on an interiorly facing side of said thermoformable layer.
12. (Previously Presented) The boot liner according to claim 11, wherein said upper portion includes an outer layer disposed on an exteriorly facing side of said thermoformable layer.
13. (Currently Amended) ~~The A boot liner according to claim 1, wherein~~
comprising:
a sole portion; and
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section, said first and second banana-shaped pads being constructed of a different material than said thermoformable layer,
each of said first and second banana-shaped pads being thicker than said thermoformable layer of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,
said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer, and
said upper portion ~~includes~~ including an inner layer disposed on an interiorly facing side of said thermoformable layer with said first and second banana-shaped pads located between said thermoformable layer and said inner layer.

14. (Cancelled)

15. (Previously Presented) The boot liner according to claim 8, wherein said first and second banana-shaped pads are formed of a polyurethane material.
16. (Previously Presented) The boot liner according to claim 27, wherein each of said first and second banana-shaped pads has a height of approximately 70 millimeters and a length of approximately 70 millimeters.
17. (Currently Amended) The boot liner according to claim 13, wherein said sole portion is a separate member that is coupled to said foot section of said upper portion.
18. (Previously Presented) The boot liner according to claim 17, wherein said sole portion is constructed of at least one flexible material.
19. (Currently Amended) The boot liner according to claim 13, wherein said sole portion includes an outer sole section that is fixedly coupled to said foot section of said upper portion.
20. (Original) The boot liner according to claim 19, wherein said outer sole section of said sole portion includes an exterior layer of a polyvinyl chloride material.
21. (Original) The boot liner according to claim 20, wherein said outer sole section of said sole portion further includes an interior thermoformable layer.
22. (Original) The boot liner according to claim 21, wherein said sole portion further includes an inner sole section that overlies said outer sole section of said sole portion.
23. (Currently Amended) The boot liner according to claim 13, wherein

said sole portion further includes ~~an~~ a thermoformable layer.

24. (Currently Amended) The boot liner according to claim ~~4~~ 23, wherein said upper portion includes a tongue portion coupled to said upper portion and arranged to span a longitudinal slit formed in said leg section, and a tightening device coupled to said upper portion for drawing opposite lateral sides of said upper portion that define said slit towards one another.

25. (Previously Presented) The boot liner according to claim 19, wherein said tightening device includes a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad.

26. (Currently Amended) The boot liner according to claim 13, wherein each of said first and second banana-shaped pads has a maximum vertical height and a maximum horizontal width that is approximately equal to said maximum vertical height to cradle the ankle bone of the wearer.

27. (Previously Presented) The boot liner according to claim 8, wherein each of said first and second banana-shaped pads has a maximum vertical height and a maximum horizontal width that is approximately equal to said maximum vertical height to cradle the ankle bone of the wearer.

28. (Currently Amended) ~~The A~~ boot liner ~~according to claim 1~~, wherein comprising:

a sole portion; and

an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said

ankle section, said first and second banana-shaped pads being constructed of a different material than said thermoformable layer,

each of said first and second banana-shaped pads being thicker than said thermoformable layer of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer, and

said upper portion ~~includes~~ including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad.

REMARKS

In the September 24, 2004 Office Action, the drawings and specification were objected to and claims 1, 6-13 and 15-27 stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Clarification of the Status of Claim 28

It is noted that claim 28 was not treated in the final Office Action. While claim 28 was listed as rejected in the Office Action Summary, no prior art was applied to claim 28 in the Office Action. Applicant respectfully requests clarification of the status of claim 28. Since no prior art was applied to claim 28, Applicant has assumed that the claim is considered allowable. Therefore, claim 28 has been incorporated into independent form.

It is further noted that claim 28 recites limitations similar to claim 8, which is believed to be allowable for the reasons set forth below.

Applicant respectfully requests entrance of this amendment and either allowance of claim 28 or a new Office Action treating claim 28 and restarting the response period.

Status of Claims and Amendments

In response to the September 24, 2004 Office Action, Applicant has amended the claims as indicated above. Claim 1 has been cancelled without prejudice and claim 13 has been made into independent form. Thus, claims 6-13 and 15-28 are pending, with claims 8, 13 and 28 being the only independent claims. Reconsideration of the pending claims is respectfully requested in view of the above amendments and the following comments.

Rejections - 35 U.S.C. § 103

In paragraph 2 of the Office Action, claims 1, 6, 7, 9-12, 17-21, 23, 26 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,012,236 (Pozzobon) in view of U.S. Patent No. 3,925,916 (Garbuio). In response, Applicant has

cancelled claim 1 as mentioned above. Dependent claims 6, 7, 9-12, 17-21, 23 and 26 now depend from independent claim 13.

In paragraph 3 of the Office Action, claims 8, 15, 16, 22, 24 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pozzobon in view of Garbuio and further in view of U.S. Patent No. 5,775,006 (Breuner).

Claim 8 recites, *inter alia*, a boot liner comprising an upper portion including a tightening device fixed thereto with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of the second banana-shaped pad. This arrangement is not disclosed or suggested by the Pozzobon, Garbuio and Breuner combination or any other prior art of record.

Claim 8 requires that the tightening device be fixed to the upper portion. The upper portion is part of the *boot liner*. Claim 8 further requires that a strap portion overly a part of the first banana-shaped pad and another strap portion overly a part of the second banana-shaped pad. In contrast, the Breuner patent discloses yokes 26 and 28, which are fixed to the *boot* 12, 18 itself not the boot liner, as described at column 5, lines 7 and 8. Furthermore, Breuner does not disclose a first or second strap portion overlying a part of a banana-shaped pad located in an ankle section, as claim 8 requires. Rather, Breuner discloses straps 50, 52, 56 that are incapable of overlying a banana-shaped pad in an *ankle section*.

For at least the reasons above, Applicant respectfully requests that this rejection be withdrawn.

In addition, claim 28 includes limitations similar to claim 8. Applicant respectfully submits that claim 28 is allowable for at least the same reasons set forth above for claim 8.

In paragraph 4 of the Office Action, claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pozzobon in view of Garbuio and further in view of U.S. Patent No. 5,746,015 (Clement et al).

Independent claim 13 recites, *inter alia*, a boot liner having an upper portion including a first banana-shaped pad located *in* the outer side of the ankle section and a second banana-shaped pad located *in* the inner side of the ankle section. Claim 13 further recites an inner layer disposed on an *interiorly* facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable and inner layers. This arrangement is not disclosed or suggested by the Pozzobon, Garbuio and Clement et al combination or any other prior art of record. It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification.

The Office Action cites Pozzobon as disclosing a boot liner having a thermoformable layer. The Office Action admits on page 2 that Pozzobon does not disclose a banana-shaped pad in a boot liner and looks to Garbuio to remedy this deficiency.

Garbuio illustrates a banana-shaped pad 8 in Figure 1. Under the Brief Description of the Drawing heading in Garbuio, Figure 1 is described as a sectional view of a *ski boot* lined with an insert. Figure 2 is described as an elevational view of the *insert without the boot*. Most importantly, Figure 2 does not show the banana-shaped pad 8. This is because the banana-shaped pad 8 is not part of the liner 2 at all. Rather, the banana-shaped pad 8 is separate from the liner 2 and, as described at column 2, line 29, is juxtaposed with the insert 2. That is, the banana-shaped pad 8 and the liner 2 are side by side. Not only is the banana-shaped pad 8 separate from the liner 2, but it is also *exteriorly* juxtaposed with the insert 2. This is in direct contradiction with claim 13, which requires a boot liner with an ankle section

having a first banana-shaped pad located *in* the outer side of the ankle section and a second banana-shaped pad located *in* the inner side of the ankle section as well as the banana-shaped pads between the thermoformable layer and the inner layer disposed on an *interiorly* facing side of the thermoformable layer.

The Office Action admits on pages 3 and 4 that Pozzobon and Garbuio do not disclose an upper portion including an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable layer and the inner layer. The Office Action looks to Clement et al to remedy this deficiency.

Clement et al discloses a boot liner having a wedging element 5 between an exterior wall 11 and an interior wall 12. Clement et al only speaks to an interior wall 12 and its application to the interior of a thermoplastic foam wedge 5. It does *not* disclose a banana-shaped pad between a thermoformable layer and an inner layer. Nor does Clement et al suggest modification of the banana-shaped pad of Garbuio, which is separate and exterior from the boot liner, such that it is part of the liner and interiorly placed. The addition of the Clement et al reference fails to give motivation to modify a banana-shaped pad separate and exterior from the a boot liner, as disclosed in Garbuio.

At best, the combination of Pozzobon, Garbuio and Clement et al discloses a liner having a thermoformable layer and an interior wall disposed on an interiorly facing side of the liner with a banana-shaped pad on the *exterior* of the liner. Dissimilarly, claim 13 requires a banana-shaped pad on the *interior* of the boot liner. That is, claim 13 states that the upper portion of the boot liner includes an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located therebetween.

Accordingly, the prior art of record lacks any suggestion or expectation of success for combining the references to create the Applicant's unique arrangement of a first banana-shaped pad located *in* the ankle section and a second banana-shaped pad located *in* the ankle section and an inner layer disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located *therebetween*.

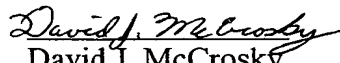
Moreover, Applicant believes that dependent claims 6, 7, 9-12 and 15-27 are also allowable over the prior art of record in that they depend from independent claims 8 and 13, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claims 8 and 13, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments.

Conclusion

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-28 are now in condition for allowance. Reconsideration of the pending claims is respectfully requested.

Respectfully submitted,


David J. McCrosky
Reg. No. 56,232

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444

Dated: December 14, 2004
G:\12-DEC04-KK\SN-US025009 AMDT.doc

EXHIBIT D



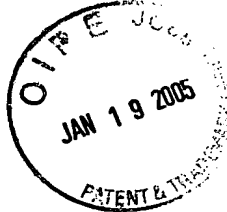
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435

22919 7590 09/24/2004

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 20TH STREET, NW, SUITE 700
WASHINGTON, DC 20036-2680



EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

SEP 27 2004



Global IP Counselors, LLP

Office Action Summary

Application No.

10/076,956

Applicant(s)

HIRAYAMA, SHUICHI

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-13 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-13 and 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6-7, 9-12, 17-21, 23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon 6,012,236 in view of Garbuio 3,925,916. Pozzobon '236 discloses a boot liner 2 with a sole portion (see Figure 1); the boot liner having an upper portion having a foot section fixedly coupled to the sole portion (see Figure 1); an ankle section extending upwardly from the foot section (also see Figure 1); a leg section extending upwardly from the ankle section (see Figure 1); the upper portion including a thermoformable layer located on an inner side and an outer side of the ankle section 103; the thermoformable layer extends along the foot section (see Figure 1); the thermoformable layer extends along the leg section (see Figure 1); the sole portion being made of the thermoformable material (same as the upper). Pozzobon '236 does not teach the banana-shaped pads located near the ankles and the limitations associated with the banana-shaped pads. Garbuio '916 discloses a first banana-shaped pad 108 located in the outer side of the ankle section; a second banana-shaped pad 108 located in the inner side of the ankle section; the banana-shaped pads made of different material than the upper and formed of polyurethane; the upper portion includes a foam layer disposed on an interiorly facing side of the thermoformable layer (inner boot layer); the upper portion includes an outer layer disposed on an exteriorly facing side of said thermoformable layer; the sole portion is a separate member that is coupled to the foot section of the upper portion; the sole portion is constructed of a flexible material; the sole portion includes an outer sole section that is fixedly coupled to said foot

Art Unit: 3728

section of the upper; the outer sole section of the sole portion the outer sole section of the sole portion includes an exterior layer of PVC material; the outer sole section of the sole portion further includes an interior thermoformable layer; the banana-shaped pads have a maximum vertical height and a maximum horizontal width that is approximately equal to the maximum vertical height. Garbuio '916 teaches that it is desirable to have these pads located on the inner boot to allow for a better and more snug fit of the boot to the user's foot. Therefore, it would have been obvious, to one of the ordinary skill in the art at the time the invention was made, to place banana-like pads, such as that taught by Garbuio '916, on the liner of Pozzobon '236, to aid in better fitting the liner to the user's foot to better translate the forces applied to the sole of the boot.

3. Claims 8, 15, 16, 22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied above in view of Bremer 5,775,006. The references as applied above disclose all the limitations of the claims except for the tightening device fixed to the upper with a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of second banana-shaped pad and the tongue and inner sole. Bremer '006 teaches that an inner sole section 46 can overlie the outer sole portion 14 to aid in gaining user comfort. Bremer '006 further teaches that a boot liner can have a tongue 48 attached thereto to close the slit in the boot to prevent ingress of unwanted material into the boot. Furthermore, Bremer '006 teaches that a strap portion can overlie a boot insert and aid in attaching the outer boot to the inner boot, thereby closing the inner boot and aiding in the prevention of ingress of unwanted material with the tongue. Therefore, it would have been obvious, to place a tongue on the inner boot upper as well as straps to attach the outer boot to the inner boot and prevent the ingress of material into the boot.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Clement et al. 5,746,015. The references as applied to claim 1 above disclose all the limitations of the claim except for the upper portion includes an inner layer

Art Unit: 3728

disposed on an interiorly facing side of the thermoformable layer with the first and second banana-shaped pads located between the thermoformable layer and the inner layer. Clement et al. '015 teaches that the upper portion of a liner can have an inner layer 12 disposed on an interiorly facing side of an outer upper layer 11 with padding 5 located there between. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an inner layer inside the thermoformable layer with the banana-like pads located there between to provide for better and proper cushioning of the boot on the user's foot.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

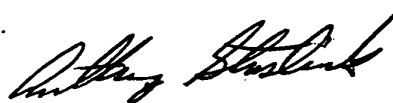
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3728

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS

Notice of References Cited

Application/Control No.

10/076,956

Applicant(s)/Patent Under
Reexamination
HIRAYAMA, SHUICHI

Examiner

Anthony Stashick

Art Unit

3728

Page 1 of 1

U.S. PATENT DOCUMENTS

* A	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-3,925,916	12-1975	Garbuio, Carlo	36/71
B	US-5,746,015	05-1998	Clement et al.	36/93
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

FOREIGN PATENT DOCUMENTS

* N	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

NON-PATENT DOCUMENTS

* U	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	
V	
W	
X	

copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
ites in MM-YYYY format are publication dates. Classifications may be US or foreign.